

REMARKS

Claims 1-30 have been examined. Claims 1-16 and 29-30 have been rejected under 35 U.S.C. § 103(a), and claims 17-28 have been allowed.

I. Preliminary matters

On page 2 of the Office Action, the Examiner indicates that the German Patent DE 3235752 ("the DE '752 patent") submitted in the Information Disclosure Statement ("IDS") filed on December 11, 2002, was not considered because it did not include a concise English explanation of relevance. Applicant respectfully disagrees.

As noted on page 2 of the IDS, a Communication from a Foreign Patent Office (i.e. a European Search Report for Application No. EP 01 30 2045) citing the DE '752 patent was submitted with the IDS. Also, the European Search Report categorized the DE '752 patent as an "A" reference (i.e. a reference that provides technical background for the examined application).

As noted in M.P.E.P. § 609(III)(A)(3), the requirement for a concise explanation of relevance for the DE '752 patent is limited to the relevance as understood by the individual (designated under 37 C.F.R. § 1.56(c)) most knowledgeable about the DE '752 patent at the time it was submitted in the IDS. Also, M.P.E.P. § 609(III)(A)(3) states:

Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

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(Emphasis added). Since the European Search Report indicates that the DE '752 patent is an "A" reference, such designation satisfies the concise English explanation of relevance requirement.

In light of the discussion above, Applicant respectfully requests the Examiner to consider the DE '752 patent and return an appropriate initialed copy of the PTO/SB/08 A & B (modified) Form.

II. Rejection under 35 U.S.C. § 103(a) over JP 58086626A to Hashizume and U.S.P. 6,310,609 B1 to Morgenthaler

Claims 1-16 and 29-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashizume and Morgenthaler.

A. Claims 1-16

Since claims 1-16 have been cancelled without prejudice or disclaimer, the rejection of such claims is moot.

B. Claim 29

Applicant submits that claim 29 would not have been obvious over Hashizume and Morgenthaler. For example, claim 29 states that a lighting device emits a first lighting color and a second lighting color to illuminate a button. Furthermore, the claim states that the button is illuminated with the first lighting color while a speaking mode is set.

On page 5 of the Office Action, the Examiner acknowledges that Hashizume does not suggest illuminating the button with the first lighting color while a speaking mode is set. However, the Examiner contends that the Abstract of Morgenthaler teaches this feature.

Morgenthaler relates to a telephone that selectively illuminates the potential buttons that a user may press to complete a particular function. For example, as described in the reference, when the user initially powers on the telephone 300, all of the buttons are illuminated for a certain period of time (Fig. 4: step 404) and then all of the buttons cease being illuminated as shown in Fig. 5A. (Fig. 4: step 406; column 6, lines 14-16).

Subsequently, if the user presses the soft key 336 to select the MENU option 324 in the display 302, the phone 300 is illuminated as shown in Fig. 5B. (Column 6, lines 45-48). As shown in Fig. 5B, the soft key 334 corresponding to the SELECT option 322, the soft key 336 corresponding to the MENU option 324, the indexing key 342, and the ABC key 328 are selectively illuminated. Such keys 334, 336, 342, and 328 are the only keys illuminated because such keys correspond to the only valid options that may be selected after the MENU option 324 is initially selected. (Column 6, lines 48-60, and column 7, lines 4-13). Moreover, if the user presses a key that is not illuminated (and does not correspond to a valid option), the phone produces an audible "beep" to inform the user of the error. (Column 6, lines 37-42).

If the user presses the soft key 334 (corresponding to the SELECT option 322) while the keys 334, 336, 342, and 328 are illuminated, the MODE selection command will be entered. (Column 7, lines 27-29). Also, the phone 300 illuminates the various keys that correspond to the options available after the MODE selection command is input. Specifically, as shown in Fig.

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5C, after inputting the MODE selection command, the soft key 334 (corresponding to the OK option 322), the soft key 336 (corresponding to the QUIT option 324), and the indexing key 342 are illuminated. (Column 7, lines 29-47).

Subsequently, if the user presses the soft key 334 (corresponding to the OK option 322) to select a particular mode (i.e. the ANALOG mode, the DIGITAL mode, or the BOTH mode), while the keys 334, 336, and 342 are illuminated, the mode selection operation is completed. In such case, as shown in Fig. 5D, the soft key 336 is illuminated (to indicate that the user can access the MENU option again) and the keypad 304 and SND key 338 are illuminated (to indicate that the user can input numbers and make a telephone call). (Column 7, line 65, to column 8, line 4).

In addition to selectively lighting the various keys to provide a "guide" to the user by informing him of the potentially valid keys that may be pressed, all of the keys may be simultaneously lit with an additional light to enable the keys to be viewed in low ambient light. (Column 5, lines 34-42). To determine whether or not the ambient light is low, a sensor 350 may be provided on the phone 300 to detect the amount of ambient light. (Fig. 3 and column 8, lines 59-61). Thus, the phone 300 has two types of lights: (1) the "guide" lights that selectively illuminate the valid buttons that a user may press and (2) the general background light that illuminates all of the keys when the ambient light is low. (Column 8, line 59, to column 9, line 15).

As demonstrated above, Morgenthaler does not suggest that a button is illuminated with the first lighting color while a speaking mode is set. The Examiner contends that such features is disclosed by the Abstract of Morgenthaler, which states:

A user interface with guide lights for a communications device, such as a mobile telephone, is provided to assist a user in the correct and efficient operation of the device having a display, and a keypad which contains a numerical 10-key and other control keys. The user interface includes a means for identifying the appropriate keys on the keypad which correspond to the step or steps required to activate a desired operation to be performed within the device. In the preferred embodiment, identification of the appropriate keys is achieved using a light source which is mounted beneath each translucent key so that when the light source is illuminated, the key associated with that light source will be identified to the user. The intensity of the light sources is variable and may be controlled to provide sufficient contrast to read all keys in low ambient light while highlighting the keys to be pressed for operation of the desired function. In high ambient light, the intensity of the guide lights may be increased for enhanced contrast and visibility. Alternatively, different color light sources may be used, with one color to light all keys for visibility in low ambient light, if needed, and the other color to provide the guide lights.

As noted above, the Abstract does not suggest illuminating a button with a first lighting color while a speaking mode is set. Accordingly, Applicant submits that claim 29 is patentable over Hashizume and Morgenthaler.

B. Claim 30

Applicant submits that claim 30 would not have been obvious Hashizume and Morgenthaler. For example, claim 30 relates to an electronic device that comprises a button having a numerical pattern and a letter pattern, Also, a lighting device illuminates the button with a first lighting color while a name input mode is set and that illuminates the button with a second lighting color while a telephone number input mode is set.

The Examiner acknowledges that Hashizume does not suggest (1) a button having both a number pattern and a letter pattern, (2) a name input mode, and (3) a telephone number input mode. However, the Examiner contends that Morgenthaler suggests the claimed button having both a number pattern and a letter pattern (i.e. item (1) above).

Based on the Examiner's analysis, she acknowledges that Morgenthaler also does not suggest the name input mode and the telephone number input mode (i.e. items (2) and (3) above). However, the Examiner contends that such features are merely obvious design choices.

Applicant submits that the Examiner has not presented a prima facie case of obviousness. Specifically, not only does Morgenthaler fail to generally disclose the name input mode and the telephone number input mode, the reference further fails to suggest illuminating a button with a first lighting color while the name input mode is set and illuminating the button with a second lighting color while the telephone number input mode is set. Thus, not only is the Examiner relying on an "obvious design choice" to support her position that the name input mode and the telephone number input mode would have been obvious, but she attenuates her "obvious design choice" logic even further. Specifically, she maintains (without any support) that (1) illuminating the button with the first lighting color while a "non-disclosed" name input mode would have been obvious and that (2) illuminating the button with a second lighting color while a "non-disclosed" telephone number input mode is set would have been obvious.

Furthermore, as noted above, Morgenthaler already employs two lights to illuminate its keys. The first light is a "guide" light that indicates the buttons that correspond to valid inputs in response to an option selected by a user. The second light is used as a general background light to illuminate all of the keys in the event that the ambient light is low.

Applicants respectfully submits that Examiner has not demonstrated that one skilled in the art would have been motivated to incorporate a third light, which illuminates a key when a name input mode is set, and a fourth light, which illuminates the key when a telephone number input mode is set. In fact, the express disclosure of Morgenthaler seems to indicate that incorporating several lights into the telephone may be difficult. For example, column 5, lines 34-42, states:

Two separate light sources may be provided for each key, with each of these light sources emitting different color light. As an illustration, LEDs having dimensions on the order of 4 mm or less would make it possible to position two such LEDs behind a key which is approximately 8 mm wide. The different color LEDs could be selectively illuminated--one color for general visibility in low ambient light, the other providing the guide light.

The fact that the Morgenthaler reference is concerned with various dimensions needed to have two lights illuminate a key indicates that incorporating two additional lights into the telephone may be difficult.

Furthermore, Applicant submits that the Examiner's reliance on "obvious design choice" to support her rejection is improper. Specifically, the Examiner's assertion that an element, not taught or suggested in any of the cited art, would have been obvious to one of ordinary skill in the art, is totally without support in the cited art and is an example of impermissible hindsight reasoning. When the Examiner asserts that there is an explicit or implicit teaching or suggestion in the prior art, he must indicate where such a teaching or suggestion appears in one of the cited references. Mere allegations by the Examiner that certain differences between the claimed subject matter and the cited prior art would have been obvious do not create a presumption of unpatentability.

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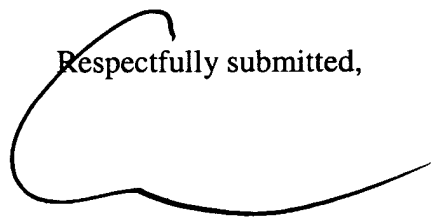
Also, the Examiner may not rely on official notice at an exact point where patentable novelty is argued, but must come forward with pertinent prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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